

Appl. No. 09/913,869  
Attr. Docket No. 7442  
Amdt. dated December 23, 2003  
Reply to Office Action of October 2, 2003  
Customer No. 27752

#### REMARKS

Claims 1, 10-12, 15-16, 18-19, 20-26, 38, and 41-46 are pending in the present application. No additional claims fee is believed to be due.

Claims 2-9, 13, 14, 17, 27-37, and 39-40 are canceled without prejudice.

Claims 1, 11, 16, 18, 20, 42, and 44-46 have been amended.

Support for the amendment to Claim 1 is found at page 4, line 32, page 5, and line 6 of the specification.

Claims 11, 16, 18, 20, 42, and 44-46 have also been rewritten to more specifically characterize the present invention.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

#### Rejection Under 35 USC 112, First Paragraph & Second Paragraph

The Office Action States Claims 1 and 10-46 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is nonenabling.

Applicants have amended Claim 1, and dependent claims therefrom to comprise a capped nonionic surfactant having the formula



wherein R1 is a linear or branched C<sub>6</sub> to C<sub>20</sub> alkyl; a is an integer from 2 to 30; b is an integer from 0 to 30; c is an integer from 1 to 10.

The Office Action States that Claims 1 and 10-46 are objected to under 35 U.S.C. 112, second paragraph, for the qualification of the capped nonionic surfactant in terms of an X/Y number greater than 1.00 and for Claim 16 including PO variations.

Applicants have amended Claims 1 and 16 to adequately provide for PO variations. Applications further submit that as explained and exemplified in the specification, one of skill in the art can easily obtain the X/Y number. While the suggestion of the Office Action is understood, Applicants' are unclear how to clarify or correct the claimed invention of the present application in view of such a suggestion.

#### Rejection Under 35 USC 102 Over EP 0 661 043

Appl. No. 09/913,869  
Atty. Docket No. 7442  
Amdt. dated December 23, 2003  
Reply to Office Action of October 2, 2003  
Customer No. 27752

The Office Action rejects Claims 1, 10-15, and 17-46 under 35 U.S.C. 102(b) as being anticipated by EP 0 661 043 to Tonomura et al.

Applicants submit that EP 0 661 043 discloses the use of the combination of a fatty acid polyoxyalkylene lower alkyl ether and a fatty acid monoglyceride.

The present invention as claimed does not teach each and every element of the claimed invention of the present application.

Rejection Under 35 USC 103(a) Over EP 0 661 043

Claims 1, 10-15, and 17-46 have been rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 661 043. Applicants respectfully traverse this rejection for two reasons. First, EP 0 661 043 does not establish a *prima facie* case of obviousness. Therefore Applicants' contend that the claimed invention is unobvious and that the rejection should be withdrawn.

The test of obviousness requires that one compare the claim's "subject matter as a whole" with the prior art "to which said subject matter pertains." 35 U.S.C. 103. The inquiry is thus highly fact-specific by design. No *per se* rules exist for obviousness. In *re Ochiai*, 37 USPQ2d 1127. To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure. In *re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make

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the proposed modification. In *re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2144.05.

EP 0 661 043, teaches the combination of a fatty acid polyoxyalkylene lower alkyl ether and a fatty acid monoglyceride to have satisfactory foaming properties. The Background section of EP 0 661 043 describes a polyoxyethylene nonionic surfactant of the ester type having unsatisfactory lather and feel in use. Pg. 2, lines 39-40. The combination of a fatty acidpolyoxyalkylene lower alkyl ether and a fatty acid monoglyceride is taught to solve the problem of foaming and feel. Pg. 3, lines 10-12; Tables 1 & 2, indicating that the combined use of lauric acid EO<sub>15</sub>Ome as the nonionic surfactant with a fatty acid monoglyceride generally causes an increase in foam volume compared to the case where EO<sub>15</sub>Ome is used alone.

As EP 0 661 043 teaches the inclusion of fatty acid monoglyceride to improve foaming, low foaming nonionic, such as those claimed in the present invention, would not be expressly or impliedly suggested to one skilled in the art. Such modifications would make the surfactants of the claimed invention of the present application unsatisfactory for its intended purpose, and therefore there is no suggestion or motivation to make the proposed modification. Additionally, EP 0 661 043, as indicated by the Office Action, is devoid of a butoxy endcapped moiety.

As such, Applicants submit that EP 0 661 043 does not give motivation to modify the teachings of EP 0 661 043 to arrive at the claimed invention of the present application, nor does EP 0 661 043 teach or suggest all of Applicants' claim limitations and therefore, does not establish a *prima facie* case of obviousness (see MPEP 2143.03).

#### Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. 112, first paragraph, second paragraph, 102 and 103.. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 10-12, 15-16, 18-19, 20-26, 38, and 41-46.

Respectfully submitted,

Page 14 of 16

Appl. No. 09/913,869  
Atty. Docket No. 7442  
Amdt. dated December 23, 2003  
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Customer No. 27752

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December 23, 2003  
Customer No. 27752  
(7442OA1.doc)  
Revised 10/14/2003